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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,661	01/10/2001	Thomas Magid	9726-2	7492

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NASH & TITUS, LLC  
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MIDDLEBURG, VA 20117

EXAMINER
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THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/757,661

**Applicant(s)**

MAGID, THOMAS

**Examiner**

Marissa Thein

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-13 and 15-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13, and 15-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's "Amendment" filed on July 14, 2004 has been considered.

The drawings filed on July 14, 2004 are acceptable.

Claims 5 and 14 are cancelled. New claims 31-34 are added. Claims 1-4, 6-13, and 15-34 remain pending in this application.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-4, 6-13, and 15-34 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1-4, 6-9, 21-22, 26, 31 and 34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. The claimed invention must utilize technology in a non-trivial manner. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as

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opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. For example in claim 1, the method claim recites "a computerized network" in the preamble of the claim and "at least one storage medium" which is a trivial use of the technology. Therefore, the claim is nothing more than an abstract idea, which is not tied to any technological art and is not a useful art. *Ex parte Bowman*, 61 USPQ2d 1665, 1671 (BD, Pats. App. & Inter. 2001). See MPEP 2106 IV 2(b).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "a central network core site comprising at least one comprising and at least...." is unclear.

Claims 1-4, 6-13, and 15-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The seller and purchaser are unclear to what the Applicant wants them to be designated. Is the seller and purchaser the computer within the network?

### ***Claim Rejections - 35 USC § 102***

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-4, 6-13, and 15-34 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,933,498 to Schneck et al.**

Regarding claims 1, 10, and 19, Schneck discloses a computerized network, method and computer program product comprising:

- a seller (data distributor) presenting a first level of disclosure of the patent or trade secret (trade secret col. 34, lines 37-40) to the purchaser via network and requesting a first response, the first response comprising a fulfillment a fulfillment of a first demand by the purchaser (see at least col. 22, lines 55-61; col. 23, lines 6-60; col. 33, lines 50-59; col. 34, lines 43-48);
- the purchaser fulfilling the first demand via the network (see at least col. 22, lines 55-61; col. 23, lines 6-60; col. 33, lines 50-59);
- the seller presenting a second level of disclosure that is more confidential and more secure than the first level of disclosures to the purchaser and requesting a second response, the second response comprising a fulfillment of a second demand by the purchaser (see at least col. 22, lines 55-61; col. 23, lines 6-60; col. 33, lines 50-59; col. 34, lines 43-48)
- the purchaser fulfilling the second demand (see at least col. 22, lines 55-61; col. 23, lines 6-60; col. 33, lines 50-59);

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- the seller and purchaser optionally entering into a contract (see at least col. 22, lines 5-61)

Regarding claims 2, 6, 8-9, 11, 15, 17-18, 20, and 22, 24, Schneck discloses seller presents additional levels of disclosure; the successive level of presenting has associated therewith and increasing level of confidentiality and security; and wherein each level of the presenting comprises revealing additional information relating to the patent or trade secret; peripheral services relating to the marketing or exchange of patents or trade secrets offered (see at least col. 16, lines 39-42; col. 20, lines 9-37; col. 22, lines 55-61; col. 23, lines 6-60; col. 33, lines 50-59; col. 22, lines 5-42).

Regarding claims 3-4 and 12-13, the recitations that “the contract is a licensing agreement” and “the contract is an assignment of rights”, such recitations are given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other “contract” already disclosed by Schneck.

Regarding claims 7 and 16, the recitation that “the demands comprise compensation, comprising one or more of money, certification authentication or agreements”, such recitation is given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other “demand” already disclosed by Schneck.

Regarding claims 21, 23, 25-30, and 32-33, Schneck discloses the first and second responses are requested by the purchaser and comprise fulfillment of a first and second demand by the seller, and the seller fulfills the first and second demands; the

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purchaser also requests a response from the seller comprising fulfillment of a demand by the seller prior to presentation of each level of disclosure; first level of disclosure is unsecure; one or more additional steps of presenting levels of disclosure and requesting responses by the seller and purchaser and fulfilling the responses (see at least col. 9, lines 55-59; col. 16, lines 39-42; col. 20, lines 9-37; col. 22, lines 55-61; col. 23, lines 6-60; col. 33, lines 50-59; col. 22, lines 5-42).

Regarding claim 31, the recitations that "patent or trade secret is for an invention to a tangible item or for a method" and "the contract permits the purchaser to make multiple copies to the tangible item or perform the method multiple times", such recitations are given little patentably weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other "patent or trade secret" and "contract" already disclosed by Schneck.

Regarding claim 34, the recitation that "the computerized network is the Internet", such recitation is given little patentably weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other "network" already disclosed by Schneck.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,050,213 to Shear discloses a database useable metering and protection system.

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U.S. Patent Application Publication No. 2001.0032189 to Powell discloses a method and apparatus for effectuating bilateral commerce in ideas.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703-308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot  
November 1, 2004

 11/1/04  
MICHAEL CUFF  
PRIMARY EXAMINER